

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Bert D. Cook, Jr. et al.  
Assignee: UltraCard, Inc.  
Title: Article Having An Embedded Accessible Storage  
Member, Apparatus And Method For Using Same  
Serial No.: 09/502,812-5712 File Date: 02/09/2000  
Examiner: Walsh, Daniel I. Art Unit: 2876  
Docket No.: ULT-001-1P

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October 25, 2006

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**SECOND APPEAL BRIEF**

Sir:

This SECOND Appeal Brief, filed in triplicate, is filed in response to the Office Communication dated May 26, 2006, and is in support of the Pre-Appeal Request for Review dated March 20, 2006, and is in furtherance to the FIRST Appeal Brief filed on May 15, 2005.

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## INDEX

I. REAL PARTY IN INTEREST. . . . .	3
II. RELATED APPEALS AND INTERFERENCES . . . . .	3
III. STATUS OF CLAIMS. . . . .	3
IV. STATUS OF AMENDMENTS. . . . .	3
V. SUMMARY OF THE CLAIMED SUBJECT MATTER . . . . .	4
VI. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL. . .	13
VII. ARGUMENTS . . . . .	14
1) <u>Claims 6, 10, 15, 19-22 and 73-76 are patentable under the judicially created doctrine of obviousness type double patenting over claims 1 and 6-11 of US Patent No. 6,867,569 (hereinafter "Smith") in view of U.S. Patent No. 5,288,942 (hereinafter "Godfrey").</u> . . . . .	14
2) <u>Claims 1-2 are rejected are patentable under 35 U.S.C. 102(b) over Godfrey because Godfrey is not directed to a "portable card" including a "storage member"</u> . . . . .	16
3) <u>Claims 6-18, 23-40, 66-74 are patentable under 35 U.S.C. 103(a) over Godfrey</u> . . . . .	20
4) <u>Claim 3 is patentable under 35 U.S.C. 103(a) over Godfrey in view of US Patent Publication No. 2001/0052543 (herein "Liu").</u> . . . . .	20
5) <u>Claims 4 and 5 is patentable under 35 U.S.C. 103 (a) over Godfrey in view of US Patent No. 6,184,788 (herein "Middlemiss")</u> . . . . .	21
VIII. CLAIMS APPENDIX . . . . .	23
IX. EVIDENCE APPENDIX . . . . .	33
X. RELATED PROCEEDINGS APPENDIX . . . . .	33

### **I. REAL PARTY IN INTEREST**

The real party in interest is the assignee, Ultracard, Inc., pursuant to the Assignment recorded in the U.S. Patent and Trademark Office on February 9, 2000 on Reel 010560, Frame 761.

### **II. RELATED APPEALS AND INTERFERENCES**

Based on information and belief, there are no other appeals or interferences that could directly affect or be directly affected by or have a bearing on the decision by the Board of Patent Appeals in the pending appeal.

### **III. STATUS OF CLAIMS**

Claims 1-40 and 66-76 are pending.

Claims 1-40 and 66-76 stand rejected.

Claims 1-40 and 66-76 are appealed.

Claims 1-40 and 66-76 are listed in the Claims Appendix (below).

### **IV. STATUS OF AMENDMENTS**

All amendments are entered.

## V. SUMMARY OF THE CLAIMED SUBJECT MATTER

This appeal involves independent Claims 1, 6, 15, 23, 66, and 73, and the subject matter of these claims finds exemplary support in the specification and drawings as follows:

### Claim 1

<u>SUBJECT MATTER</u>	<u>SPECIFICATION</u>	<u>DRAWINGS</u>
1. A portable card comprising:	-page 97, line 9 to page 98, line 13 (card 980) -page 98, line 14 to page 99, line 3 (card 1020) -page 99, lines 6 to 17 (card 1060) -page 99, line 18 to page 100, line 14 (card 1080) -page 100, line 15 to page 104, line 4 (card 2000) -page 104, line 15 to page 105, line 15 (card) -page 105, line 16 to page 106, line 2 (card 2058) -page 106, line 3 to page 106, line 17 (card 2070) -page 106, line 18 to page 107, line 2 (card 3000) -page 107, line 3 to page 107, line 11 (card 3020) -page 107, line 12 to page 107, line 21 (card 3040)	-Figs. 60(A) to 62 -Figs. 63(A) and 63(B) -Figs. 63(C) and 63(D) -Figs. 64(A) to 64(C) -Figs. 65(A) to 66(I) -Figs. 67(A) to 67(C) -Figs. 68(A) to 68(C) -Figs. 69(A) and 69(B) -Figs. 70 and 71 -Fig. 72 -Fig. 73
a substrate having a predetermined shape; and	-page 97, line 9 to page 98, line 13 (substrate 982) -page 98, line 14 to page 99, line 3 (substrate 1026) -page 99, lines 6 to 17 (substrate 1064) -page 99, line 18 to page 100, line 14 (substrate 1084) -page 100, line 15 to page 104, line 4 (substrate 2002) -page 104, line 15 to page 105, line 15 (substrate layers 2042, 2044) -page 105, line 16 to page 106, line 2 (substrate layers 2062, 2066, 2064, 2068) -page 106, line 3 to page 106, line 17 (substrate layers 2072, 2074) -page 106, line 18 to page 107, line 2 (substrate 3004) -page 107, line 3 to page	-Figs. 60(A) to 62 -Figs. 63(A) and 63(B) -Figs. 63(C) and 63(D) -Figs. 64(A) to 64(C) -Figs. 65(A) to 66(I) -Figs. 67(A) to 67(C) -Figs. 68(A) to 68(C) -Figs. 69(A) and 69(B) -Figs. 70 and 71 -Fig. 72

	107, line 11 (substrate 3024) -page 107, line 12 to page 107, line 21 (substrate 3042)	-Fig. 73
an accessible embedded storage member having at least one layer of storage material for storing information enclosed by said substrate, said storage member and said substrate being adapted to be transported relative to each other to expose at least a portion of said storage member to facilitate processing of stored information and for embedment of said storage member within said substrate.	-page 97, line 9 to page 98, line 13 (member 986) -page 98, line 14 to page 99, line 3 (members 1030, 1032 and 1034) -page 99, lines 6 to 17 (members 1066, 1068 and 1070) -page 99, line 18 to page 100, line 14 (member 1088) -page 100, line 15 to page 104, line 4 (member 2004) -page 104, line 15 to page 105, line 15 (on layers 2042, 2044) -page 105, line 16 to page 106, line 2 (on layers 2062, 2066, 2064, 2068) -page 106, line 3 to page 106, line 17 (on layers 2072, 2074) -page 106, line 18 to page 107, line 2 (member 3010) -page 107, line 3 to page 107, line 11 (members 3030 and 3032) -page 107, line 12 to page 107, line 21 (member 3050 and 3052)	-Figs. 60(A) to 62 -Figs. 63(A) and 63(B)  -Figs. 63(C) and 63(D)  -Figs. 64(A) to 64(C) -Figs. 65(A) to 66(I) -Figs. 67(A) to 67(C)  -Figs. 68(A) to 68(C)  -Figs. 69(A) and 69(B)  -Figs. 70 and 71 -Fig. 72  -Fig. 73

### Claim 6

<u>SUBJECT MATTER</u>	<u>SPECIFICATION</u>	<u>DRAWINGS</u>
6. A portable card adapted to interact with a data processing station when the portable card and the data processing station are moved relative to each other, comprising:	-page 97, line 9 to page 98, line 13 (card 980) -page 98, line 14 to page 99, line 3 (card 1020) -page 99, lines 6 to 17 (card 1060) -page 99, line 18 to page 100, line 14 (card 1080) -page 100, line 15 to page 104, line 4 (card 2000) -page 104, line 15 to page 105, line 15 (card) -page 105, line 16 to page 106, line 2 (card 2058) -page 106, line 3 to page 106, line 17 (card 2070) -page 106, line 18 to page 107, line 2 (card 3000) -page 107, line 3 to page	-Figs. 60(A) to 62 -Figs. 63(A) and 63(B) -Figs. 63(C) and 63(D) -Figs. 64(A) to 64(C) -Figs. 65(A) to 66(I) -Figs. 67(A) to 67(C) -Figs. 68(A) to 68(C) -Figs. 69(A) and 69(B) -Figs. 70 and 71 -Fig. 72

	107, line 11 (card 3020) -page 107, line 12 to page 107, line 21 (card 3040)	-Fig. 73
a substrate having a predetermined shape; and	-page 97, line 9 to page 98, line 13 (substrate 982) -page 98, line 14 to page 99, line 3 (substrate 1026) -page 99, lines 6 to 17 (substrate 1064) -page 99, line 18 to page 100, line 14 (substrate 1084) -page 100, line 15 to page 104, line 4 (substrate 2002) -page 104, line 15 to page 105, line 15 (substrate layers 2042,2044) -page 105, line 16 to page 106, line 2 (substrate layers 2062,2066,2064,2068) -page 106, line 3 to page 106, line 17 (substrate layers 2072, 2074) -page 106, line 18 to page 107, line 2 (substrate 3004) -page 107, line 3 to page 107, line 11 (substrate 3024) -page 107, line 12 to page 107, line 21 (substrate 3042)	-Figs. 60(A) to 62 -Figs. 63(A) and 63(B) -Figs. 63(C) and 63(D) -Figs. 64(A) to 64(C)  -Figs. 65(A) to 66(I) -Figs. 67(A) to 67(C)  -Figs. 68(A) to 68(C)  -Figs. 69(A) and 69(B)  -Figs. 70 and 71 -Fig. 72  -Fig. 73
an accessible embedded storage member enclosed within said substrate, said accessible storage member having at least one layer of storage material for storing information in a predetermined format for processing by a data processing station, said storage member and said substrate being adapted to be transported relative to each other to expose at least a portion of said storage member to a data processing station to facilitate processing of stored information and for embedment of said storage member within said substrate.	-page 97, line 9 to page 98, line 13 (member 986) -page 98, line 14 to page 99, line 3 (members 1030, 1032 and 1034) -page 99, lines 6 to 17 (members 1066, 1068 and 1070) -page 99, line 18 to page 100, line 14 (member 1088) -page 100, line 15 to page 104, line 4 (member 2004) -page 104, line 15 to page 105, line 15 (on layers 2042,2044) -page 105, line 16 to page 106, line 2 (on layers 2062,2066,2064,2068) -page 106, line 3 to page 106, line 17 (on layers 2072, 2074) -page 106, line 18 to page 107, line 2 (member 3010) -page 107, line 3 to page 107, line 11 (members 3030 and 3032) -page 107, line 12 to page 107, line 21 (member 3050 and 3052)	-Figs. 60(A) to 62 -Figs. 63(A) and 63(B)  -Figs. 63(C) and 63(D)  -Figs. 64(A) to 64(C) -Figs. 65(A) to 66(I) -Figs. 67(A) to 67(C)  -Figs. 68(A) to 68(C)  -Figs. 69(A) and 69(B)  -Figs. 70 and 71 -Fig. 72  -Fig. 73

**Claim 15**

<u>SUBJECT MATTER</u>	<u>SPECIFICATION</u>	<u>DRAWINGS</u>
15. A portable card adapted to be used in a card processing system having a data processing station comprising:	-page 97, line 9 to page 98, line 13 (card 980) -page 98, line 14 to page 99, line 3 (card 1020) -page 99, lines 6 to 17 (card 1060) -page 99, line 18 to page 100, line 14 (card 1080) -page 100, line 15 to page 104, line 4 (card 2000) -page 104, line 15 to page 105, line 15 (card) -page 105, line 16 to page 106, line 2 (card 2058) -page 106, line 3 to page 106, line 17 (card 2070) -page 106, line 18 to page 107, line 2 (card 3000) -page 107, line 3 to page 107, line 11 (card 3020) -page 107, line 12 to page 107, line 21 (card 3040)	-Figs. 60(A) to 62 -Figs. 63(A) and 63(B) -Figs. 63(C) and 63(D) -Figs. 64(A) to 64(C) -Figs. 65(A) to 66(I) -Figs. 67(A) to 67(C) -Figs. 68(A) to 68(C) -Figs. 69(A) and 69(B) -Figs. 70 and 71 -Fig. 72 -Fig. 73
a substrate having a predetermined shape; and	-page 97, line 9 to page 98, line 13 (substrate 982) -page 98, line 14 to page 99, line 3 (substrate 1026) -page 99, lines 6 to 17 (substrate 1064) -page 99, line 18 to page 100, line 14 (substrate 1084) -page 100, line 15 to page 104, line 4 (substrate 2002) -page 104, line 15 to page 105, line 15 (substrate layers 2042, 2044) -page 105, line 16 to page 106, line 2 (substrate layers 2062, 2066, 2064, 2068) -page 106, line 3 to page 106, line 17 (substrate layers 2072, 2074) -page 106, line 18 to page 107, line 2 (substrate 3004) -page 107, line 3 to page 107, line 11 (substrate 3024) -page 107, line 12 to page 107, line 21 (substrate 3042)	-Figs. 60(A) to 62 -Figs. 63(A) and 63(B) -Figs. 63(C) and 63(D) -Figs. 64(A) to 64(C) -Figs. 65(A) to 66(I) -Figs. 67(A) to 67(C) -Figs. 68(A) to 68(C) -Figs. 69(A) and 69(B) -Figs. 70 and 71 -Fig. 72 -Fig. 73
a removable and reinsertable accessible embedded storage member having at least one layer of storage material for	-page 97, line 9 to page 98, line 13 (member 986) -page 98, line 14 to page 99, line 3 (members 1030, 1032 and 1034)	-Figs. 60(A) to 62 -Figs. 63(A) and 63(B)

storing information enclosed by said substrate, said storage member and said substrate being adapted to be transported relative to each other to remove and expose at least a portion of said storage member to facilitate processing of stored information by a data processing station and for embedment of said storage member within said substrate.	-page 99, lines 6 to 17 (members 1066, 1068 and 1070) -page 99, line 18 to page 100, line 14 (member 1088) -page 100, line 15 to page 104, line 4 (member 2004) -page 104, line 15 to page 105, line 15 (on layers 2042,2044) -page 105, line 16 to page 106, line 2 (on layers 2062,2066,2064,2068) -page 106, line 3 to page 106, line 17 (on layers 2072, 2074) -page 106, line 18 to page 107, line 2 (member 3010) -page 107, line 3 to page 107, line 11 (members 3030 and 3032) -page 107, line 12 to page 107, line 21 (member 3050 and 3052)	-Figs. 63(C) and 63(D)  -Figs. 64(A) to 64(C) -Figs. 65(A) to 66(I) -Figs. 67(A) to 67(C)  -Figs. 68(A) to 68(C)  -Figs. 69(A) and 69(B)  -Figs. 70 and 71 -Fig. 72  -Fig. 73
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### Claim 23

<u>SUBJECT MATTER</u>	<u>SPECIFICATION</u>	<u>DRAWINGS</u>
23. A portable card adapted to be used in a card processing system having a data processing station comprising:	-page 97, line 9 to page 98, line 13 (card 980) -page 98, line 14 to page 99, line 3 (card 1020) -page 99, lines 6 to 17 (card 1060) -page 99, line 18 to page 100, line 14 (card 1080) -page 100, line 15 to page 104, line 4 (card 2000) -page 104, line 15 to page 105, line 15 (card) -page 105, line 16 to page 106, line 2 (card 2058) -page 106, line 3 to page 106, line 17 (card 2070) -page 106, line 18 to page 107, line 2 (card 3000) -page 107, line 3 to page 107, line 11 (card 3020) -page 107, line 12 to page 107, line 21 (card 3040)	-Figs. 60(A) to 62 -Figs. 63(A) and 63(B) -Figs. 63(C) and 63(D) -Figs. 64(A) to 64(C) -Figs. 65(A) to 66(I) -Figs. 67(A) to 67(C) -Figs. 68(A) to 68(C) -Figs. 69(A) and 69(B) -Figs. 70 and 71 -Fig. 72  -Fig. 73
a substrate having a substantially planar and generally rectangular shape; and	-page 97, line 9 to page 98, line 13 (substrate 982) -page 98, line 14 to page 99, line 3 (substrate 1026) -page 99, lines 6 to 17 (substrate 1064) -page 99, line 18 to page 100, line 14 (substrate 1084)	-Figs. 60(A) to 62 -Figs. 63(A) and 63(B) -Figs. 63(C) and 63(D) -Figs. 64(A) to 64(C)



	<p>-page 100, line 15 to page 104, line 4 (substrate 2002)</p> <p>-page 104, line 15 to page 105, line 15 (substrate layers 2042,2044)</p> <p>-page 105, line 16 to page 106, line 2 (substrate layers 2062,2066,2064,2068)</p> <p>-page 106, line 3 to page 106, line 17 (substrate layers 2072, 2074)</p> <p>-page 106, line 18 to page 107, line 2 (substrate 3004)</p> <p>-page 107, line 3 to page 107, line 11 (substrate 3024)</p> <p>-page 107, line 12 to page 107, line 21 (substrate 3042)</p>	<p>-Figs. 65(A) to 66(I)</p> <p>-Figs. 67(A) to 67(C)</p> <p>-Figs. 68(A) to 68(C)</p> <p>-Figs. 69(A) and 69(B)</p> <p>-Figs. 70 and 71</p> <p>-Fig. 72</p> <p>-Fig. 73</p>
<p>at least one removable and reinsertable accessible embedded storage member having at least one layer of storage material for storing information enclosed by said substrate, said storage member and said substrate being adapted to be transported relative to each other to remove and expose at least a portion of said storage member to facilitate processing of stored information by a data processing station and for embedment of said storage member within said substrate.</p>	<p>-page 97, line 9 to page 98, line 13 (member 986)</p> <p>-page 98, line 14 to page 99, line 3 (members 1030, 1032 and 1034)</p> <p>-page 99, lines 6 to 17 (members 1066, 1068 and 1070)</p> <p>-page 99, line 18 to page 100, line 14 (member 1088)</p> <p>-page 100, line 15 to page 104, line 4 (member 2004)</p> <p>-page 104, line 15 to page 105, line 15 (on layers 2042,2044)</p> <p>-page 105, line 16 to page 106, line 2 (on layers 2062,2066,2064,2068)</p> <p>-page 106, line 3 to page 106, line 17 (on layers 2072, 2074)</p> <p>-page 106, line 18 to page 107, line 2 (member 3010)</p> <p>-page 107, line 3 to page 107, line 11 (members 3030 and 3032)</p> <p>-page 107, line 12 to page 107, line 21 (member 3050 and 3052)</p>	<p>-Figs. 60(A) to 62</p> <p>-Figs. 63(A) and 63(B)</p> <p>-Figs. 63(C) and 63(D)</p> <p>-Figs. 64(A) to 64(C)</p> <p>-Figs. 65(A) to 66(I)</p> <p>-Figs. 67(A) to 67(C)</p> <p>-Figs. 68(A) to 68(C)</p> <p>-Figs. 69(A) and 69(B)</p> <p>-Figs. 70 and 71</p> <p>-Fig. 72</p> <p>-Fig. 73</p>

**Claim 66**

<b><u>SUBJECT MATTER</u></b>	<b><u>SPECIFICATION</u></b>	<b><u>DRAWINGS</u></b>
66. A data storage device comprising	-page 97, line 9 to page 98, line 13 (card 980) -page 98, line 14 to page 99, line 3 (card 1020) -page 99, lines 6 to 17 (card 1060) -page 99, line 18 to page 100, line 14 (card 1080) -page 100, line 15 to page 104, line 4 (card 2000) -page 104, line 15 to page 105, line 15 (card) -page 105, line 16 to page 106, line 2 (card 2058) -page 106, line 3 to page 106, line 17 (card 2070) -page 106, line 18 to page 107, line 2 (card 3000) -page 107, line 3 to page 107, line 11 (card 3020) -page 107, line 12 to page 107, line 21 (card 3040)	-Figs. 60(A) to 62 -Figs. 63(A) and 63(B) -Figs. 63(C) and 63(D) -Figs. 64(A) to 64(C) -Figs. 65(A) to 66(I) -Figs. 67(A) to 67(C) -Figs. 68(A) to 68(C) -Figs. 69(A) and 69(B) -Figs. 70 and 71 -Fig. 72 -Fig. 73
a substrate; and	-page 97, line 9 to page 98, line 13 (substrate 982) -page 98, line 14 to page 99, line 3 (substrate 1026) -page 99, lines 6 to 17 (substrate 1064) -page 99, line 18 to page 100, line 14 (substrate 1084) -page 100, line 15 to page 104, line 4 (substrate 2002) -page 104, line 15 to page 105, line 15 (substrate layers 2042, 2044) -page 105, line 16 to page 106, line 2 (substrate layers 2062, 2066, 2064, 2068) -page 106, line 3 to page 106, line 17 (substrate layers 2072, 2074) -page 106, line 18 to page 107, line 2 (substrate 3004) -page 107, line 3 to page 107, line 11 (substrate 3024) -page 107, line 12 to page 107, line 21 (substrate 3042)	-Figs. 60(A) to 62 -Figs. 63(A) and 63(B) -Figs. 63(C) and 63(D) -Figs. 64(A) to 64(C) -Figs. 65(A) to 66(I) -Figs. 67(A) to 67(C) -Figs. 68(A) to 68(C) -Figs. 69(A) and 69(B) -Figs. 70 and 71 -Fig. 72 -Fig. 73
an accessible embedded storage member having a predetermined shape, said storage member having at least one layer of storage material for storing	-page 97, line 9 to page 98, line 13 (member 986) -page 98, line 14 to page 99, line 3 (members 1030, 1032 and 1034) -page 99, lines 6 to 17	-Figs. 60(A) to 62 -Figs. 63(A) and 63(B) -Figs. 63(C)

information enclosed by said substrate, said storage member and said substrate being adapted to be transported relative to each other to expose at least a portion of said storage member to facilitate processing of stored information.	(members 1066, 1068 and 1070) -page 99, line 18 to page 100, line 14 (member 1088) -page 100, line 15 to page 104, line 4 (member 2004) -page 104, line 15 to page 105, line 15 (on layers 2042,2044) -page 105, line 16 to page 106, line 2 (on layers 2062,2066,2064,2068) -page 106, line 3 to page 106, line 17 (on layers 2072, 2074) -page 106, line 18 to page 107, line 2 (member 3010) -page 107, line 3 to page 107, line 11 (members 3030 and 3032) -page 107, line 12 to page 107, line 21 (member 3050 and 3052)	and 63(D)  -Figs. 64(A) to 64(C) -Figs. 65(A) to 66(I) -Figs. 67(A) to 67(C)  -Figs. 68(A) to 68(C)  -Figs. 69(A) and 69(B)  -Figs. 70 and 71 -Fig. 72   -Fig. 73
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### Claim 73

<u>SUBJECT MATTER</u>	<u>SPECIFICATION</u>	<u>DRAWINGS</u>
73. A magnetically encoded card comprising	-page 97, line 9 to page 98, line 13 (card 980) -page 98, line 14 to page 99, line 3 (card 1020) -page 99, lines 6 to 17 (card 1060) -page 99, line 18 to page 100, line 14 (card 1080) -page 100, line 15 to page 104, line 4 (card 2000) -page 104, line 15 to page 105, line 15 (card) -page 105, line 16 to page 106, line 2 (card 2058) -page 106, line 3 to page 106, line 17 (card 2070) -page 106, line 18 to page 107, line 2 (card 3000) -page 107, line 3 to page 107, line 11 (card 3020) -page 107, line 12 to page 107, line 21 (card 3040)	-Figs. 60(A) to 62 -Figs. 63(A) and 63(B) -Figs. 63(C) and 63(D) -Figs. 64(A) to 64(C) -Figs. 65(A) to 66(I) -Figs. 67(A) to 67(C) -Figs. 68(A) to 68(C) -Figs. 69(A) and 69(B) -Figs. 70 and 71 -Fig. 72  -Fig. 73
a substrate having a predetermined shape; and	-page 97, line 9 to page 98, line 13 (substrate 982) -page 98, line 14 to page 99, line 3 (substrate 1026) -page 99, lines 6 to 17 (substrate 1064) -page 99, line 18 to page 100, line 14 (substrate 1084) -page 100, line 15 to page	-Figs. 60(A) to 62 -Figs. 63(A) and 63(B) -Figs. 63(C) and 63(D) -Figs. 64(A) to 64(C)  -Figs. 65(A)

	104, line 4 (substrate 2002) -page 104, line 15 to page 105, line 15 (substrate layers 2042,2044) -page 105, line 16 to page 106, line 2 (substrate layers 2062,2066,2064,2068) -page 106, line 3 to page 106, line 17 (substrate layers 2072, 2074) -page 106, line 18 to page 107, line 2 (substrate 3004) -page 107, line 3 to page 107, line 11 (substrate 3024) -page 107, line 12 to page 107, line 21 (substrate 3042)	to 66(I) -Figs. 67(A) to 67(C)  -Figs. 68(A) to 68(C)  -Figs. 69(A) and 69(B)  -Figs. 70 and 71 -Fig. 72  -Fig. 73
an accessible embedded storage member having at least one layer of magnetic recording material for storing information enclosed by said substrate, said storage member and said substrate being adapted to be transported relative to each other to expose at least a portion of said storage member to facilitate processing of stored information by a transducer and for embedment of said storage member within said substrate.	-page 97, line 9 to page 98, line 13 (member 986) -page 98, line 14 to page 99, line 3 (members 1030, 1032 and 1034) -page 99, lines 6 to 17 (members 1066, 1068 and 1070) -page 99, line 18 to page 100, line 14 (member 1088) -page 100, line 15 to page 104, line 4 (member 2004) -page 104, line 15 to page 105, line 15 (on layers 2042,2044) -page 105, line 16 to page 106, line 2 (on layers 2062,2066,2064,2068) -page 106, line 3 to page 106, line 17 (on layers 2072, 2074) -page 106, line 18 to page 107, line 2 (member 3010) -page 107, line 3 to page 107, line 11 (members 3030 and 3032) -page 107, line 12 to page 107, line 21 (member 3050 and 3052)	-Figs. 60(A) to 62 -Figs. 63(A) and 63(B)  -Figs. 63(C) and 63(D)  -Figs. 64(A) to 64(C) -Figs. 65(A) to 66(I) -Figs. 67(A) to 67(C)  -Figs. 68(A) to 68(C)  -Figs. 69(A) and 69(B)  -Figs. 70 and 71 -Fig. 72  -Fig. 73

## VI. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

The following rejections are presented to the Board of Appeals for decision:

1) Claims 6, 10, 15, 19-22 and 73-76 are rejected as being un patentable under the judicially created doctrine of obviousness type double patenting over claims 1 and 6-11 of US Patent No. 6,867,569 (hereinafter "Smith") in view of U.S. Patent No. 5,288,942 (hereinafter "Godfrey")

2) Claims 1-2 are rejected are patentable under 35 U.S.C. 102(b) over Godfrey;

3) Claims 6-18, 23-40 and 66-74 are rejected as unpatentable under 35 U.S.C. 103(a) over Godfrey;

4) Claim 3 is rejected as unpatentable under 35 U.S.C. 103(a) over Godfrey in view of U.S. Published Patent Application No. US2001/00052543 (hereinafter "Liu"); and

5) Claims 4-5 are rejected as unpatentable under 35 U.S.C. 103(a) over Godfrey in view of U.S. Patent No. 6,184,788 (hereinafter "Middlemiss").

## VII. ARGUMENTS

Claims 1-18, 23-40 and 66-74 were finally rejected on September 15, 2004. Applicant appealed the rejection, and submitted an Appeal Brief on May 16, 2005. Examiner Walsh reopened prosecution on September 21, 2005, and issued the currently-pending non-final Office action on October 19, 2005. Presently, Claims 1-40 and 66-76 stand rejected.

1) Claims 6, 10, 15, 19-22 and 73-76 are patentable under the judicially created doctrine of obviousness type double patenting over claims 1 and 6-11 of US Patent No. 6,867,569 (hereinafter "Smith") in view of U.S. Patent No. 5,288,942 (hereinafter "Godfrey").

Applicant respectfully traverses the obviousness-type double patenting rejection as improper. The purpose for rejecting claims under both statutory and non-statutory obviousness-type double patenting is to prevent the unjustified extension of patent exclusivity beyond the term of a patent (MPEP Section 804). In the present case, Claim 1 of Smith is clearly patentably distinguished over Claim 6 of the present application (both copied below for reference):

### Smith Claim 1

1. A data unit comprising:
  - a data card comprising
    - a non-magnetic substrate and a magnetic material layer for storing signals in a plurality of parallel linear data tracks;
  - a data card reader comprising
    - a data head reciprocally movable along a first linear path that is parallel to the plurality of parallel linear data tracks when the plurality of parallel linear data tracks are respectively positioned for signal communication with the data head.

6. A portable card adapted to interact with a data processing station when the portable card and a the data processing station are moved relative to each other, comprising:

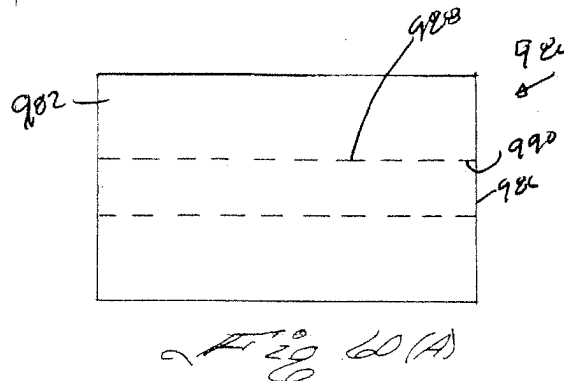
- a substrate having a predetermined shape; and
- an accessible embedded storage member enclosed within said substrate, said accessible storage member having at least one layer of storage material for storing information in a predetermined format for processing by a data processing station, said storage member and said substrate being adapted to be transported relative to each other to expose at least a portion of said storage member to a data processing station to facilitate processing of stored information and for embedment of said storage member within said substrate.

As emphasized above, Claim 1 of Smith is directed to a "data unit", and, in contrast, pending independent Claim 6 is directed to a "portable card" (Claim 15 is also directed to a "portable card", and Claim 73 is directed to a "magnetically encoded card"). Claim 1 of Smith recites a "data card reader" that is not recited in pending Claims 6, 15 and 73, and Claims 6, 15, and 73 recite an "accessible embedded storage member" that is not recited in Smith. Clearly, the scope of the claimed invention in Smith is entirely different than the scope of the claims in the present application.

Applicant respectfully argues that the present rejection is unsupportable at best, and perhaps may be considered frivolous. Reconsideration and withdrawal is therefore requested.

2) Claims 1-2 are patentable under 35 U.S.C. 102(b) over Godfrey.

The claimed invention is directed to a credit card-type "portable card" including a card-like "substrate" housing a "storage member" for storing information. An exemplary portable card is disclosed in Applicants' Fig. 60(A) (reproduced below for reference with corresponding text from page 97 of Applicants' specification):



The embodiment of a portable card 980 illustrated in Figs. 60(A), 60 (B) and 60 (C) has a substrate 982 formed of a predetermined shape, e.g. rectangular, square, circular or the like. The predetermined shape of the preferred embodiment illustrated in Figs. 60(A), 60 (B) and 60 (C) is that of a credit card. (Page 97, lines 9-14.)

Independent Claim 1 recites that the "portable card" includes a "storage member having at least one layer of storage material for storing information". Claim 1 also recites that the "storage member" is housed in the "substrate" such that "said storage member and said substrate being adapted to be transported relative to each other to ... expose at least a portion of said storage member to ... facilitate processing of stored information".



In contrast to the credit card-type "portable card" recited in independent Claim 1, Godfrey is clearly directed to a credit card holder that includes a "keeper" held between outer covers that form a pocket for receiving a credit card:

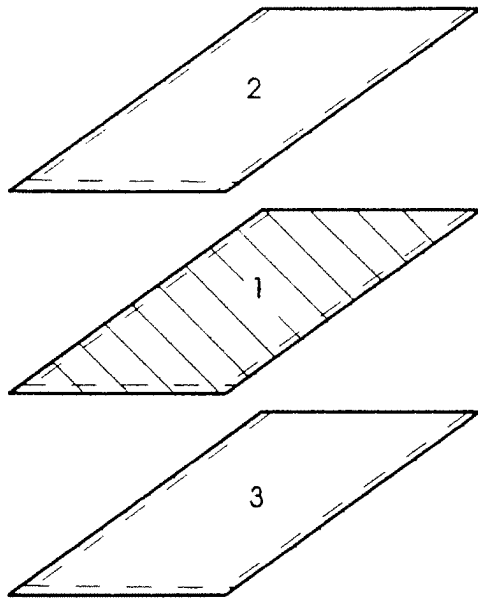


Fig. 2

Godfrey, column 3, lines 4-25

The best mode for carrying out the invention is a cardholder for two credit cards. In FIG. 2, part 1 is the keeper, a first embodiment of said keeper being a composite sheet 0.1 mm thick with a smooth, low friction surface finish. The sheet composition is a fine powder of magnetically soft iron, a polymer such as pvc or polyethylene and a suitable binder, making a material of 10 high resistivity. The soft iron powder content is as high as possible consistent with the requirements of mechanical strength and smooth surface finish of the sheet.

The sheet is homogeneous but an alternative would be a polymer substrate coated on both sides with the 15 ferromagnetic material in a suitable binder. The technology for fabrication of this type of sheet is well known, for example in the manufacture of recording tape and computer floppy discs (which, incidentally, use magnetically hard material). 20

The outer covers (parts 2 and 3) are covers made of 0.05 mm thick transparent pvc and may be attached by glueing, welding, stitching or whatever is best suited to the method of manufacture. (Note that known cardholders consist of parts 2 and 3 only). 25

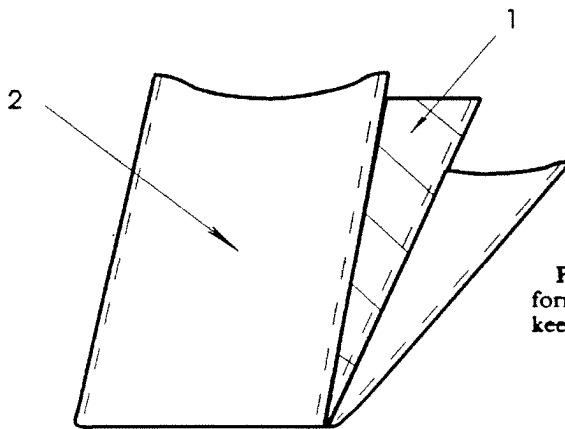


Fig. 3

Godfrey, column 3, lines 55-57

FIG. 3 shows an embodiment of the invention in the 55 form of a cardholder which can be made using one keeper (1) and a folded cover (2).

In rejecting Claim 1 under 35 USC 102 over Godfrey, the Examiner repeats the identical argument previously raised in his rejection under 35 USC 103:

Re claim 1, Godfrey teaches a portable card comprising a substrate having a predetermined shape; and an accessible embedded storage member having at least one layer of storage material for storing information enclosed by the substrate, the storage member and the substrate being adapted to be transported relative to each other to expose at least a portion of the storage member to facilitate processing of stored information and for embedment of the storage member with the substrate (FIG. 3, abstract, and col 1, lines 5+).

Godfrey's Fig. 3 is reproduced above, and Godfrey's abstract and Col 1, lines 5-12 are copied below for reference:

[57]

#### ABSTRACT

In the technical field of known cardholders for devices such as cards with magnetic stripes on which is encoded information and or data in the form of patterns of magnetism, the known cardholders offer no method of 'keeping' (in magnetism terminology) the magnetic patterns. The present invention is characterised by incorporating into the cardholders, keepers in the form of sheets of magnetically soft ferromagnetic material with high resistance. The benefit of the invention is obtained when devices are placed with the reading surface of their magnetized stripes in close contact with the surface of the ferromagnetic material which, making use of known properties of the material, then acts as keeper of the magnetic patterns.

Godfrey, column 1, lines 5-12

#### TECHNICAL FIELD

In the technical field of holders for devices on which information and/or data is encoded in the form of patterns of magnetism, the present invention concerns a method of 'keeping' (in magnetism terminology) the said magnetic patterns. The term 'patterns' includes any arrangement of magnetism such as regular or irregular lines, dots, waves, areas of magnetism, areas of reversed polarity and unmagnetised areas.

Applicant respectfully traverses the Examiner's characterization of Godfrey as teaching a "portable card", and as including a "storage member...for storing information". As underlined by Applicant's attorney in Godfrey's Abstract and Technical Field above, Godfrey's "keeper" is a clearly a sheet of magnetically soft ferromagnetic material with high resistance whose purpose of is not to store information, but to prevent loss of information from, e.g., credit cards that are stored in the credit card holder (see, for example, column 1, lines 25-35,

and column 2, lines 17-24, both reproduced below for reference):

Godfrey, column 1, lines 25-35

Possibly not so well known is the fact that the magnetic patterns are subject to gradual degradation due to the natural thermal activity and slowing down of the magnetic spin of the molecules of the magnetised material. Such degradation can be reduced by the use of 'keepers' to establish low reluctance paths to enable the magnetic lines of force to complete their natural circuits. To achieve this result a keeper should be in close contact with the face of the device from which lines of magnetism, emanate, i.e. the face from which the encoded information is read.

Godfrey, column 2, lines 17-24

The benefit of the invention is obtained when devices, such as credit cards, are inserted into the card-holders with the reading surfaces of their magnetized components in close contact with the surfaces of the keepers. To avoid physical damage to the magnetized components, the keepers having a smooth, low friction and/or lubricated surface finish.

Because Godfrey's "keeper" does not store information, Applicants contend that Godfrey's credit card holder is no more a "portable card" than a purse is a credit card. As such, Godfrey fails to anticipate the "portable card" of Claim 1 because Godfrey fails to teach or suggest the "storage member" recited in Claim 1. Further, it would not have been obvious to replace the Godfrey's keeper with a "storage member" because to do so would defeat the entire purpose of Godfrey's stated invention. For at least these reasons, Godfrey fails to anticipate the subject matter of Claim 1, and it would not have been obvious to modify Godfrey to produce the "portable card" recited in Claim 1.

Claim 2 depends from Claim 1, and is therefore distinguished over Godfrey for at least the reasons provided above with reference to Claim 1.

3) Claims 6-18, 23-40 and 66-74 is patentable under 35 U.S.C. 103(a) over Godfrey.

Similar to Claim 1, independent Claims 6, 15, 23, and 66 recite a "portable card" including a "storage member having at least one layer of storage material for storing information" (Claim 73 is slightly different). Each of these independent claims also recites that the "storage member" is housed in the "substrate" such that "said storage member and said substrate being adapted to be transported relative to each other to ... expose at least a portion of said storage member to ... facilitate processing of stored information". As such, Claims 6, 15, 23, and 66 are distinguished over Godfrey and any other cited prior art for reasons similar to those provided above with reference to Claim 1.

Claims 7-14 are dependent from Claim 6, Claims 16-18 are dependent from Claim 15, Claims 24-40 are dependent from Claim 23, Claims 67-72 are dependent from Claim 66, and Claim 74 is dependent from Claim 73. Accordingly, each of these claims is distinguished over Godfrey for at least the reasons provided above with reference to Claim 1.

4) Claim 3 is patentable under 35 U.S.C. 103(a) over Godfrey in view of U.S. Published Patent Application No. US2001/00052543 (Liu).

Claim 3 is dependent from Claim 1, and is therefore distinguished over Godfrey for at least the reasons provided above. Liu is directed to a magnetic cardreader system, and is cited by the Examiner for teaching "circular storage members" (Office Action, page 5). It would not have been obvious to combine the teachings of Godfrey and Liu to produce the "portable card" of Claim 1 because, as set forth above, Godfrey's keeper is not a "storage member", and replacing Godfrey's keeper with the "circular storage member"

taught by Liu would defeat the purpose of Godfrey's invention. Therefore, the rejection of Claim 3 over Godfrey and Liu is improper and should be withdrawn.

5) Claims 4 and 5 is patentable under 35 U.S.C. 103(a) over Godfrey in view of U.S. Patent No. 6,184,788 (Middlemiss).

Claim 4 and 5 are also dependent from Claim 1, and are therefore distinguished over Godfrey for at least the reasons provided above. Middlemiss is directed to an electronic missing card alert case, and is cited by the Examiner for teaching "clamshell type cardholder" (Office Action, page 6, second paragraph). It would have been neither possible nor obvious to combine the teachings of Godfrey and Middlemiss to produce the "portable card" of Claim 1 because, as set forth above, neither Godfrey nor Middlemiss are directed to portable cards including "storage members", and modifying Godfrey's holder with the "clamshell type cardholder" taught by Middlemiss would not overcome this deficiency. Therefore, the rejection of Claims 4 and 5 over Godfrey and Middlemiss is improper and should be withdrawn.

For the foregoing reasons, it is submitted that the Examiner's rejections of Claims 1-18, 23-40, 66-74 are erroneous, and reversal of these rejections is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Patrick T. Bever". The signature is fluid and cursive, with the first name "Patrick" written in a larger, more prominent script than the last name "Bever".

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### VIII. CLAIMS APPENDIX

1. (Previously Presented) A portable card comprising:  
a substrate having a predetermined shape; and  
an accessible embedded storage member having at least one layer of storage material for storing information enclosed by said substrate, said storage member and said substrate being adapted to be transported relative to each other to expose at least a portion of said storage member to facilitate processing of stored information and for embedment of said storage member within said substrate.

2. (Original) The portable card of claim 1 wherein said storage member is in the form of an elongated strip member.

3. (Original) The portable card of claim 1 wherein said storage member is in the form of a circular member.

4. (Original) The portable card of claim 1 wherein said substrate has first layer and a second layer each having an obverse side and a converse side operatively coupled to each other with the obverse side of said first layer positioned in an opposed relationship from the converse side of said second layer enabling at least a portion of said first layer to be moveable relative to said second layer and wherein a storage member is located on at least one of the obverse side of said first layer and converse side of said second layer.

5. (Original) The portable card of claim 4 wherein first layer and a second layer are pivotally mounted relative to each other enabling movement in a first direction exposing at least a portion of at least one of the storage member located on the obverse side of said first layer and the storage member located on the converse side of said second layer to

facilitate processing of stored information and enabling movement in a direction opposite to said first direction to embed said at least one storage member within said substrate.

6. (Previously Presented) A portable card adapted to interact with a data processing station when the portable card and a the data processing station are moved relative to each other, comprising:

a substrate having a predetermined shape; and  
an accessible embedded storage member enclosed within said substrate, said accessible storage member having at least one layer of storage material for storing information in a predetermined format for processing by a data processing station, said storage member and said substrate being adapted to be transported relative to each other to expose at least a portion of said storage member to a data processing station to facilitate processing of stored information and for embedment of said storage member within said substrate.

7. (Original) The portable card of claim 6 wherein said at least one layer of storage material for storing information in a predetermined format is a magnetic medium.

8. (Original) The portable card of claim 6 wherein said at least one layer of storage material for storing information in a predetermined format is an optical medium.

9. (Original) The portable card of claim 6 wherein said at least one layer of storage material for storing information in a predetermined format is a magneto-optical medium.



10. (Previously Presented) The portable card of claim 6 wherein said at least one layer of storage material for storing information in a predetermined format is at least one layer of high density, high coercivity magnetic material for storing magnetic signals.

11. (Previously Presented) The portable card of claim 6 further comprising:

an abradable protective coating formed on said magnetic material layer.

12. (Original) The portable card of claim 6 wherein said substrate is moved relative to said data processing station.

13. (Original) The portable card of claim 6 wherein said data processing station is moved relative to said substrate.

14. (Original) The portable card of claim 6 wherein said data processing station and said substrate are moved relative to each other.

15. (Previously Presented) A portable card adapted to be used in a card processing system having a data processing station comprising:

a substrate having a predetermined shape; and

a removable and reinsertable accessible embedded storage member having at least one layer of storage material for storing information enclosed by said substrate, said storage member and said substrate being adapted to be transported relative to each other to remove and expose at least a portion of said storage member to facilitate processing of stored information by a data processing station and for embedment of said storage member within said substrate.

16. (Original) The portable card of claim 15 wherein said storage member has at least one layer of high density, high coercivity magnetic material for storing magnetic signals.

17. (Previously Presented) The portable card of claim 16 wherein said storage member further includes:

an abradeable protective coating formed on said magnetic material layer.

18. (Original) The portable card of claim 17 wherein said at least one magnetic material layer is a thin film layer of high density, high coercivity magnetic material having a predetermined magnetic field orientation for storing data.

19. (Original) The portable card of claim 17 wherein the protective coating has at least one layer which includes a magnetically permeable, magnetically saturable material.

20. (Original) The portable card of claim 17 wherein the protective coating has at least two layers wherein one of said layers includes a magnetically permeable, magnetically saturable material and the other of said layers is a non-magnetic friction reducing layer formed on said one of said layers.

21. (Original) The portable card of claim 17 wherein said at least one magnetic material layer is formed of a high density, high coercivity magnetic material having a predetermined magnetic field orientation and wherein said protective coating has at least one layer which includes a

magnetically permeable, magnetically saturable material and wherein said data storage device further includes:

a non-magnetic material layer positioned between the protective coating and said at least one magnetic material layer, said magnetically permeable, magnetically saturable material being responsive through said non-magnetic layer to predetermined magnetic field orientation to produce a magnetic image field in a direction opposite to said predetermined magnetic field orientation.

22. (Original) The portable card of claim 17 said at least one magnetic material layer is formed of a high density, high coercivity magnetic material having a predetermined magnetic field orientation and wherein said protective coating has at least two layers wherein said one of said layers includes a magnetically permeable, magnetically saturable material and the other of said layers is a non-magnetic abrasion friction reducing layer formed on said one of said layers and wherein said data storage device further includes:

a non-magnetic material layer positioned between the protective coating and said at least one magnetic material layer, said magnetically permeable, magnetically saturable material being responsive through said non-magnetic layer to predetermined magnetic field orientation to produce a magnetic image field in a direction opposite to said predetermined magnetic field orientation.

23. (Previously Presented) A portable card adapted to be used in a card processing system having a data processing station comprising:

a substrate having a substantially planar and generally rectangular shape; and

at least one removable and reinsertable accessible embedded storage member having at least one layer of storage material for storing information enclosed by said substrate, said storage member and said substrate being adapted to be transported relative to each other to remove and expose at least a portion of said storage member to facilitate processing of stored information by a data processing station and for embedment of said storage member within said substrate.

24. (Original) The portable card of claim 23 wherein said at removable and reinsertable accessible embedded storage generally rectangular in shape.

25. (Original) The portable card of claim 23 wherein said at removable and reinsertable accessible embedded storage generally circular in shape.

26. (Original) The portable card of claim 23 wherein said substrate encloses at least two removable and reinsertable accessible embedded storage members which are generally rectangular in shape.

27. (Previously Presented) The portable card of claim 23 wherein said substrate encloses at least three removable and reinsertable accessible embedded storage members which are generally rectangular in shape.

28. (Original) The portable card of claim 23 wherein said substrate has two opposing surfaces and one of said two opposing surfaces includes an integrated circuit located thereon.

29. (Original) The portable card of claim 23 wherein said data processing station includes a transducer.

30. (Original) The portable card of claim 23 wherein said at least one layer of storage material is a magnetic medium and said transducer is an inductive head.

31. (Original) The portable card of claim 23 wherein said at least one layer storage material is a magnetic medium and said transducer is a thin film head.

32. (Original) The portable card of claim 23 wherein said at least one layer storage material is a magnetic-optical medium and said transducer is a magnetoresistive head.

33. (Original) The portable card of claim 23 wherein said at least one layer storage material is a magnetic medium and said transducer is a giant magnetoresistive (GMR) head.

34. (Previously Presented) The portable card of claim 30 wherein said at least one layer of magnetic material has a predetermined magnetic field orientation that is substantially perpendicular to a data processing station.

35. (Original) The portable card of claim 30 wherein said at least one layer of magnetic material has a predetermined magnetic field orientation that is substantially parallel to a data processing station.

36. (Original) The portable card of claim 30 wherein said at least one layer of magnetic material has a predetermined magnetic field orientation that is at an acute angle to a data processing station.

37. (Original) The portable card of claim 30 wherein said magnetic medium is at least one thin film layer of high density, high coercivity magnetic material is a sputtered layer.

38. (Original) The portable card of claim 37 wherein said magnetic medium is least one thin film layer of high density, high coercivity magnetic material is a plated layer.

39. (Original) The portable card of claim 30 wherein said at least one thin film layer of high density, high coercivity magnetic material is an oxide layer.

40. (Original) The portable card of claim 31 wherein said at least one thin film layer of high density, high coercivity magnetic material is a web coated layer.

41-65. (Cancelled)

66. (Previously Presented) A data storage device comprising a substrate; and

an accessible embedded storage member having a predetermined shape, said storage member having at least one layer of storage material for storing information enclosed by said substrate, said storage member and said substrate being adapted to be transported relative to each other to expose at least a portion of said storage member to facilitate processing of stored information.

67. (Original) The data storage device of claim 66 wherein said storage member and said substrate are adapted to

be transported relative to each other for embedment of said storage member within said substrate.

68. (Original) The data storage device of claim 66 wherein said storage member includes at least one layer of high density, high coercivity magnetic material for storing data.

69. (Previously Presented) The data storage device of claim 68 wherein said storage member includes:

an abradable protective coating formed on said magnetic material layer.

70. (Original) The data storage device of claim 69 wherein the magnetic material layer is formed of a substantially isotropic material.

71. (Original) The data storage device of claim 70 wherein the isotropic material is a magnetic thin film alloy including platinum.

72. (Original) The data storage device of claim 69 wherein the magnetic material is formed of an anisotropic material.

73. (Previously Presented) A magnetically encoded card comprising a substrate having a predetermined shape; and

an accessible embedded storage member having at least one layer of magnetic recording material for storing information enclosed by said substrate, said storage member and said substrate being adapted to be transported relative to each other to expose at least a portion of said storage member to facilitate processing of stored information by a

transducer and for embedment of said storage member within said substrate.

74. (Previously Presented) The magnetically encoded card of claim 73 further comprising:

a bendable, abradeable protective coating formed on said at least one layer of magnetic material.

75. (Original) The magnetically encoded card of claim 74 wherein said protective coating includes a magnetically permeable, magnetically saturable material as an independent layer disposed on said substrate.

76. (Original) The magnetically encoded card of claim 75 wherein said protective coating includes a non-magnetic friction resisting material as a separate layer disposed on said magnetically permeable, magnetically saturable material.

77-84. (Cancelled)



IX. EVIDENCE APPENDIX

Not used.

X. RELATED PROCEEDINGS APPENDIX

Not used.